

### **REMARKS/ARGUMENTS**

The Office Action dated January 6, 2009 has been carefully considered. It is believed that the following comments represent a complete response to the Examiner's comments and place the present application in condition for allowance. Reconsideration is respectfully requested.

#### **35 USC §103**

The Examiner has rejected claims 1, 3, 5-13, 16-19 and 32-53 under 35 USC §103 as being obvious in light of Cobley (U.S. Patent No. 6,528,687) in view of Abdur-Rashid (WO 03/097571).

According to the Examiner, Cobley teaches a process of making an amine from an imine in the presence of a base, a ruthenium complex of a chiral diphosphine and a chiral diamine. The Examiner contends that Cobley teaches a process wherein the substituent ( $R^3$  in formula 10 or 11) on the nitrogen is a non-interfering organic group, and the Examiner has interpreted this group to be hydrogen substituted C-C double bond or C-C triple bond. The Examiner admits that while the variable  $R^3$  in Cobley is an alkylaryl group, the variable  $R^3$  in the present application is an alkyl group. To remedy this deficiency in Cobley, the Examiner cites Abdur-Rashid for its teaching of the hydrogenation of dialkyl, alkylalkenyl or dialkenyl imines. Accordingly, the Examiner alleges that the presently claimed process of preparing an amine from an imine would have been obvious. The Applicant respectfully traverses the Examiner's objection.

The Applicant respectfully submits that the Examiner's obviousness objection is improper as Abdur-Rashid is not a citable prior art reference. Section 2132.01 of the Manual of Patent Examining Procedure (current web edition) states that

when the reference is a U.S. patent published within the year prior to the application filing date, a 35 U.S.C. 102(e) rejection should be made.

Abdur-Rashid was published on November 27, 2003, which is within one year of the priority date of the present application. Therefore, the assessment of obviousness is to be made according to the provisions of 35 USC 102(e).

The Applicant submits that the present application and Abdur-Rashid were commonly owned at the time the present application was filed, and therefore, is not citable prior art under 35 USC 102(e). The Applicant directs the Examiner's attention to Section 715.01(b) of the Manual of Patent Examining Procedure (current web edition), where it states:

Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. [emphasis added]

In support of the above, the Applicant has submitted with this Response, a Declaration which refers to an assignment which transferred the ownership of the Abdur-Rashid application, from Robert H. Morris to Kamaluddin Abdur-Rashid, before the filing date of the present application. Consequently, as Abdur-Rashid and the present application are commonly owned, the Applicant respectfully submits that Abdur-Rashid is not citable prior art.


In light of the above, the Applicant requests that the Examiner's rejection of claims 1, 3, 5-19 and 25-53 under 35 USC §103(a) as being obvious in light of Cobley be withdrawn.

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication of that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater detail, he is invited to contact the undersigned by telephone at (416) 957-1665 at his convenience.

Respectfully submitted,

**KAMALUDDIN ABDUR-RASHID**

By   
\_\_\_\_\_  
Michael Fenwick  
Reg. No. 61,773

Bereskin & Parr LLP  
Box 401, 40 King Street West  
Toronto, Ontario  
Canada M5H 3Y2  
Tel: 416-957-1665  
Fax: 416-361-1398